



IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Berkema et al.

Confirmation No.: 9755

Application No.: 09/897,647

Examiner: Poon, King Y.

Filing Date: June 29, 2001

Group Art Unit: 2624

Title: PRINT BY REFERENCE SERVICE METHOD

Mail Stop Appeal Brief-Patents  
Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 2/6/2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

( ) one month	\$120.00
( ) two months	\$450.00
( ) three months	\$1020.00
( ) four months	\$1590.00

( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Berkema et al.

Serial No.: 09/897,647

Conf. No.: 9755

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For: PRINT BY REFERENCE SERVICE  
METHOD

Art Unit: 2624

Examiner: Poon, King Y.

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.

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Date  
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APPELLANT'S BRIEF ON APPEAL PURSUANT TO RULE 192

REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

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### **RELATED APPEALS AND INTERFERENCES**

A Notice of Appeal was filed January 23, 2006 for U.S. Patent Application Serial No. 09/897,693, and an appeal brief was filed March 23, 2006. A Notice of Appeal was filed February 13, 2006 for U.S. Patent Application Serial No. 09/897,656. These Applications are not technically related but disclose related subject matter.

### **STATUS OF CLAIMS**

Claims pending, finally rejected and appealed 1-5, 7-24, and 23-35. Claim 7 also stands objected to.

### **STATUS OF AMENDMENTS**

No amendments were filed after the final Office Action dated October 4, 2005.

### **SUMMARY OF CLAIMED SUBJECT MATTER**

Claim 1 is directed to a method for serving a print by reference operation to print referenced content from a referenced location of a content provider 18 to a print device 10. FIGs. 1-2; P4, L2-4; P7, L16-19. This allows content to be accessed from a content provider, typically a web site via the Internet. P4, L13-14; P5, L9; P6, L18; P6, L27-29; FIGs. 1-2. In the method of claim 1, a reference to print content 32 targeted for printing from a content provider location 18 indicated by the reference is accepted. FIG. 2; P6, L27-29. The reference is resolved 42 to determine the location indicated by the reference. P7, L16-18. Print data is obtained 44 from the location (i.e., the content provider location) indicated by the reference. The print data is transcoded 46 into a print device ready format, and access is allowed 30 to this transcoded print data. FIGs. 1-2; P7, L26-29. In response to a request from the print client, transcoded print data is transferred 48. P8, L9-10.

According to independent claim 7, a method (see, e.g., FIG. 2) is defined for serving a print by reference operation to print referenced content from a referenced location<sup>1</sup> 18 to a print device 10. The method comprises accepting 32, from a print client 10, 16, a reference to print content targeted for printing from a location 18 indicated by the reference. P6, L27-29. The reference is resolved 42 to determine the location indicated by the reference. P7, L16-18. Print data is obtained 44 from the location indicated by the reference, and the print data is transcoded 46 into a print device ready format. P7, L26-29. Access is allowed 30 to the transcoded print data, and in response to a request from the print client, transcoded print data is transferred 48. P8, L9-10.

Further, according to claim 7, a control communication 50, 52 (FIG. 3) is initiated with the print client. This is conducted via an argument resolution protocol 56. The accepting and transferring and conducted via a data transfer protocol 54. According to dependent claim 8, the argument resolution protocol is Simple Object Access Protocol (SOAP), and a data transfer protocol is an HTTP protocol (FIG. 3). P8, L15-25.

Independent claim 14 defines a print service 12, 14 realized as a computer program product comprising a computer usable medium having computer readable program code embodied in the medium. FIG. 1; P4, L3-6, L23-29. When executed, the computer is caused to perform a method similar to that defined in claim 1. As further defined in dependent claim 27, the print service receives a control communication 52 (FIG. 3) with a print client 10, 16 over a control communication channel 52, which is an argument resolution protocol 56, and as defined in dependent claim 28, this protocol is more specifically Simple Object Access Protocol (SOAP). As further defined in dependent claim 27, a separate data channel 54 is opened for data exchange. P8, L15-25.

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<sup>1</sup> Applicants recognize and note herein that the additional words “of a” after “referenced location” are incorrectly included in claim 7 in its current form. This informality has been cited by the Examiner (see “Status of Claims”), but has not yet been addressed by amendment due to the pending appeal. Applicants intend to correct this informality by deleting “of a” if Applicants succeed in obtaining reversal of the rejection after the Board’s decision regarding patentability of this claim.

### **ISSUES TO BE REVIEWED ON APPEAL**

1. The rejection under 35 U.S.C. §102(b) of claims 1-4 as being anticipated by Eldridge.
2. The rejection under 35 U.S.C. §103(a) of claim 5 as being unpatentable over Eldridge.
3. The rejection of claims 7 and 8 under 35 U.S.C. §103(a) as being unpatentable over Eldridge in view of Petteruti, W3C SOAP 1.1 and Gase.
4. The rejection of claim 9 under 35 U.S.C. §103(a) as being unpatentable over Eldridge and Holtzman.
5. The rejection of claim 10 under 35 U.S.C. §103(a) as being unpatentable over Eldridge, Hotzman and Hull.
6. The rejection of claim 11 under 35 U.S.C. §103(a) as being unpatentable over Eldridge, Iwata, and Hull.
7. The rejection of claims 12-13 under 35 U.S.C. §103(a) as being unpatentable over Eldridge in view of Srinivasan.
8. The rejection of claims 14, 16, 23-29, 32 and 34-35 under 35 U.S.C. §103(a) as being unpatentable based on the rejections of claims 1-13.
9. The rejection of claim 15 under 35 U.S.C. §103(a) as being unpatentable over Eldridge.
10. The rejection of claims 17-19 and 21 under 35 U.S.C. §103(a) as being unpatentable over Eldridge and Srinivasan.
11. The rejection of claim 20 under 35 U.S.C. §103(a) as being unpatentable over Eldridge and Srinivasan and further in view of Olkkonen.
12. The rejection of claims 30-31 under 35 U.S.C. §103(a) as being unpatentable over Eldridge, Petteruti, W3C SOAP 1.1 and Gase.

13. The rejection of claim 33 under 35 U.S.C. §103(a) as being unpatentable over Eldridge, Hull and Reece.

## **ARGUMENT**

### **I. The 35 U.S.C. §102(b) Rejection Of Claims 1-4 as Being Anticipated by Eldridge.**

#### **A. The §102(b) Rejection of Claim 1 Should be Reversed, as The Specific Token-Based Service in Eldridge Teaches Accessing a Document Server Where Users Can Print by Reference Their Own Documents, and Thus Does not Teach Printing Referenced Content From a Content Provider Location, or Accepting a Reference to a Content Provider Location From A Print Client.**

Claim 1 defines a “method for serving a print by reference operation to print referenced content from a referenced location of a content provider to a print device” (emphasis added). This method requires, among other things, “accepting, from a print client, a reference to print content targeted for printing from a content provider location indicated by the reference” (emphasis added). The cited reference, Eldridge, neither teaches nor suggests printing referenced content from a referenced location of a content provider, nor does it teach accepting a reference to print content from a content provider location indicated by the reference.

The Examiner states (October 4, 2005 Office Action, P2) that Eldridge teaches a method for serving a print by reference operation to print referenced content from referenced location of a content provider to a print device, citing FIG. 4, and C11, L52 - C12, L7. This cited section discloses a method for context based transaction with tokens between a portable device and a network (e.g., see C11, L58 – C12, L2). The Examiner

further alleges on the same page that Eldridge teaches accepting a reference (a token) to print content targeted for printing from a content provider location indicated by the reference, citing FIGs. 1 and 4, step S8, C9, L44 - C10, L2, and C8, L6-7, because the “token/reference contains a URL for retrieval of a document located at an address of URL”).

However, Eldridge neither discloses nor suggests at least that the print content is from a content provider location. Preferred embodiments to the invention provide a generalized print service to facilitate the printing by reference of content from content providers. For example, according to the present application, “A likely scenario involves a portable wireless device 16 accessing a content provider 18, typically a web site over the internet. The web site might include a link to print content, such as a ‘print this’ or link. If selected, the print by reference target is transmitted to the portable wireless device 16, which then can commence a print by reference operation with the print device 10.” P5, L8-13. This is unlike the system of Eldridge or the other token-based document servers (e.g., see Eldridge, C1, L20-26; C8, L6-10, C10, L9-14) upon which Eldridge is based.

For example, as discussed in C1, L20-35 of Eldridge, the reference is directed to a document server that includes print-by-reference operations where users can print-by-reference their own documents by providing a document token. “Each portable device emulates its user’s personal satchel for documents: the device is programmed to receive transmit and store document references (World Wide Web URLs), each of which is associated with an electronic document stored in an electronic repository at a site on the web.” C1, L25-30. In Eldridge, the “satchel” includes one or more tokens. C5, L9-22. The tokens include information to associate a document with the user, which is the owner of the document: “the token having a plurality of token components, each token component defining a document related entity and property of the entity.” C3, L25-30. The documents may be stored on an intranet or the Internet (C7, L41-50; see also C12, L50-52 “file server 52 (which may be in a different building or in a different country), although it will be appreciated that the document could be stored locally on the workstation 50”), but the mobile

device initiating a print by reference operation requires the device first to provide the document tokens by having created it or possibly by receiving via email or other means. C11, L56 - C12, L55.

Eldridge's system and methods do not disclose or suggest the invention of claim 1, wherein the reference to printed content is to print content of a content provider that is separate from the print service, instead of the user's own documents that are associated with a token on a token server. As disclosed at C6, L47-50 of Eldridge, "A token contains the small amount of essential information which allows the system (token-capable server software resident on public networks and private networks) to initiate actions which produce the desire result." See also C12, L47-54, which states, "An element of this routine is the request for a document held in an electronic repository". In fact, the purpose of Eldridge's system and the manner of realization is quite different from the system defined in claim 1. Eldridge has limited application and is concerned only with providing access to a user's documents (C5, L9-14, L24-30; see also C10, L1-7: "In this way it is only the token that is transmitted from the personal portable device via wireless means and then...communications are used to move the actual document data...to the end device"), whether they may have been previously created or received by email or otherwise. Eldridge does not provide a solution for printing by reference content of a content provider with use of a web based or local print service. The invention defined in claim 1, on the other hand, provides print service solutions for printing by reference of generalized content, e.g., from content providers, and the user need not have previously received a secure token (e.g., see C12, L41-45: "the first step (s11) is to decode the token: this involves checking the Authorization...") to be able to conduct the print by reference operation.

**B. The Examiner's Statements Regarding the Teaching of Eldridge Contradict the Meaning of "Content Provider", as the Term is Used in the**

**Present Application, and Under the Term's Ordinary Meaning as Would be Understood by an Artisan.**

The Examiner submits (October 4, 2005 Office Action, page 14) that Eldridge (C3, L55-58, and C4, L1-2) “clearly teaches print by reference content of a content provider (the data processing device that is storing the documents) with use of a web based (Internet, column 8, line 5) or local print service”.

However, the Examiner’s interpretation of “content provider” is contrary to both the present specification’s clear use of the term and its ordinary meaning to an artisan. Claim 1 has been amended by Applicants (see Amendment A, claim 1) to specifically and clearly define that the print content is from a content provider location, as opposed to merely any location that stores documents. The specification’s use of the term and the ordinary meaning of the term make clear that a content provider is not a server that stores a user’s own documents, as do Eldridge’s document servers (see, e.g., Eldridge, C12, L47-54).

“The ordinary and customary meaning of a claim term to one of ordinary skill in the art may be ascertained from a variety of sources, first, as *Vitronics* instructs, from the intrinsic evidence of record such as the claims themselves, the written description, and the prosecution history, but also from the ‘common understanding’ of the terms that may be reflected in dictionaries, encyclopedias, and treatises.” *W.E. Hall Co., Inc. v. Atlanta Corrugating, LLC*, 370 F.3d 1343, 1350 (Fed. Cir. 2004) (citation omitted). Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302 (Fed. Cir. 2003).

The broadest reasonable interpretation of the claims to be given during examination by the USPTO must be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353 (Fed. Cir. 1999). Claim terms must be given

the definition indicated in the specification and the claim. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1585 (Fed. Cir. 1996).

For example, as stated in the present specification, the content provider 18 is “typically a website over the internet.” P5, L9; see also FIG. 1. This point is also made at P6, L18: “The content provider 18 is also typically a web site”. As further provided at page 5, L8-16: “The website might include a link to print content, such as a ‘print this’ link. If selected, the print by reference target is transmitted by the portable wireless device 16 which then can commence a print by reference operation with the print device 10.” Reading this, no artisan would interpret Eldridge’s token based document server that stores a user’s own documents as a content provider.

With regard to ordinary meaning, the specification and claim usage is consistent with ordinary meaning, and contrary to the interpretation of Eldridge’s document servers as stated by the Examiner. A web search for “content provider” on Yahoo search engine, for example (referred to in Amendment B, P8, L25 – P9, L2, see also Evidentiary Appendix A herewith), provides examples of financial content providers, stock market providers, scholastic information content providers, etc. Further, a search on the USPTO’s patent database for TTL\ “content provider” (see Evidentiary Appendix B herewith) reveals ten patents that use the word content provider in the title, and these patents use “content provider” in a manner generally consistent with the use by Applicants.

The Examiner submits (December 14, 2005 Advisory Action, P2, L6-7), “There is no reason why a content provider, a web site, a stock market content provider, etc. can not be a computer or a server computer.” However, the mere idea that a content provider can be a computer or a server computer does not somehow turn a document server for storing a user’s own documents, as clearly and deliberately disclosed in Eldridge (see, e.g., Eldridge, C12, L47-54; C1, L26-32), into a “content provider”.

In sum, it is improper to call Eldridge’s document server that store user’s own documents “content providers”. Doing so is contrary to the claims interpreted in the

specification and their ordinary meaning. Accordingly, the rejection of claim 1 and claims depending therefrom should be reversed.

**II. The 35 U.S.C. §103(a) Rejection of Claim 5 as Being Unpatentable Over Eldridge.**

Applicants respectfully submit that the 35 U.S.C. §103(a) rejection based on Eldridge should be reversed for at least the reasons stated above regarding independent claim 1, which are incorporated herein.

**III. The 35 U.S.C. §103(a) Rejection of Claims 7 And 8 as Being Unpatentable Over Eldridge in View of Petteruti, W3CSOAP 1.1 and Gase.**

**A. The Rejection of Claim 7 Should be Reversed, as There is no Motivation to Modify the Unique, Clear, and Deliberate Token-Based System of Eldridge Based on the Other Three Cited References to Initiate a Control Communication Via an Argument Resolution Protocol.**

Independent claim 7 provides a server of a preferred embodiment that makes a particular use of an argument resolution protocol. Particularly, claim 7 requires, among other things, “accepting, from a print client, a reference to print content targeted for printing from a location indicated by the reference,” “transferring, in response to a request from the print client, print data transcoded by said step of transcoding,” and “initiating a control communication with a print client.” Further, “said step of initiating a control communication is conducted via an argument resolution protocol and said steps of accepting and transferring

are conducted via a data transfer protocol.” The use of initiating a control communication via an argument resolution protocol, and the separate control and data communications, defined in claim 7, are unaccounted for in the Examiner’s rejection.

Regarding claim 7, the Examiner recognizes (October 4, 2005 Office Action, P5, L3-4) that Eldridge does not teach the step of initiating a control communication with the print client. However, the Examiner cites Petteruti, C6, L24-25, for this feature, and he concludes that it would have been obvious to have used the control communication initiated with the print client, as taught by Petteruti, in the method of Eldridge because “it provides a method for additional functionality, wherein the portable device is not the only device that initiates control communication.” October 4, 2005 Office Action, P5, L9-11.

The Examiner further recognizes (October 4, 2005 Office Action, P5, L12-15) that neither Eldridge nor Petteruti teaches initiating a control communication via an argument resolution protocol, let alone Simple Object Access Protocol (SOAP), nor that the claimed steps of accepting and transferring are conducted via a data transfer protocol. However, the Examiner cites a third reference, W3C SOAP 1.1, for the general teaching of SOAP for transmissions between the sender and a receiver, “in this case a control communication initiator and the print client”. October 4, 2005 Office Action, P5, L16-18. Additionally, the Examiner cites yet another reference, Gase, for teaching an HTTP protocol used for data transfer in a print by reference system “similar to that taught by Eldridge” October 4, 2005 Office Action, P6, L3-4).

The Examiner alleges that it would have been obvious to have used the SOAP taught by W3C to initiate control communication in the method taught by Eldridge and Petteruti because “SOAP can be binded to HTTP, providing the advantage of being able to use the formalism and decentralized flexibility of SOAP with the rich feature set of HTTP,” October 4, 2005 Office Action, P6, L1-2, and that it would have been obvious to use the HTTP protocol taught by Gase in the method taught by Eldridge, Petteruti, and W3C because

“it allows for data transfer over the world wide web (Gase, column 11, lines 27-29) and it would compliment the use of SOAP”. October 4, 2005 Office Action, P6, L5-8.

However, Applicants submit that this combination is improper. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Examiner, to teach just the feature of initiating a control communication with a print client via an argument resolution protocol and accepting a reference and transferring a reference via a data protocol, has carefully pieced together teachings of four separate references, namely Eldridge, Petteruti, W3C, and Gase, while providing no clear motivation to combine their teachings other than, apparently, the presumption that each modification to the invention of Eldridge would be an improvement. This suggests a use of hindsight reconstruction of the invention of claim 7 (this suggestion is further supported by the use of 12 separate theories of obviousness based on a multitude of combinations – see October 4, 2005 Office Action, P4-14).

The Examiner’s suggested combination also is unsupported by the references. With regard to claim 7 specifically, the stated basis for the overall combination is that, “It allows for data transfer over the World Wide Web (Gase, column 11, lines 27-29) and it would compliment SOAP.” October 4, 2005 Office Action, P6, L8-9. This, however, fails to find support in the references for a number of reasons. One reason is that Eldridge already

has document access over the World Wide Web, See, e.g., Eldridge, C1, L26-30; C8, L1-10. An artisan would not be motivated to look to the (three) additional references for providing Web access therefore.

Another reason is that none of the second, third or fourth references are specifically directed to print by reference operations. See, e.g., Petteruti, abstract (directed to a system for RF communication between a host and a portable printer); Gase, abstract and C2, L28-46 (directed to enabling remote control of a print queue in a network printer having a browser); W3C SOAP 1.1, Introduction (stating that SOAP does not itself define any application semantics, but is simply a mechanism for expressing application semantics.) The combination (especially when considered with the large number of other combinations applied – see October 4, 2005 Office Action, P4-14) indicates that claim 7 was used as a road map for constructing the rejection.

Yet another reason the Examiner's purported combination is improper is that the token-based servers used by Eldridge define an independent protocol that is deliberately token-based (see, e.g., Eldridge, C1, L20-35; C2, L6-24; C9, L10-13; C9, L44 – C10, L13; C11, L55 – C12, L7; C14, L26-42) and it is not clear how the additional references suggest modification of such an independent, token-based protocol. If a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The Examiner has not addressed this issue.

**B. The Examiner’s Explanations for Combining the References Attempt to Shift the Burden of Making a *Prima Facie* Case for Obviousness to Applicants.**

The Examiner submits (October 4, 2005 Office Action, page 14), “SOAP is a lightweight protocol for the exchange of information and a decentralized distributed environment.” However, this statement, apparently taken from the white paper on SOAP (e.g., see W3C SOAP 1.1, Abstract and Introduction), is irrelevant because it is the Examiner’s burden to make a *prima facie* case to demonstrate specific motivation evidence to modify Eldridge. The fact that SOAP is a “lightweight protocol” in no way suggests its use in Eldridge, where Eldridge already discloses delivering encoded tokens over the web (Eldridge, C1, L26-32; C8, L6-10; see also Introduction of W3C SOAP 1.1: “SOAP does not itself define any application semantics such as a programming model or implementation specific semantics”). Mere possibilities, e.g., that it might be possible to use SOAP in Eldridge’s system, do not demonstrate that it would have been obvious to do so. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

**C. The Examiner’s Explanations for Combining the References Rely on a Vague “Print By Reference Concept” and Ignore the Clear Teachings of Eldridge.**

The Examiner further submits (October 4, 2005 Office Action, page 15), “The print by reference *concept* does not require any specific any specific protocol...*and this is the reason why Eldridge does not disclose any communication rules and regulations*” (emphasis

added). This statement is completely speculative. It is not clear what is meant by the “print by reference concept”. Apparently, the Examiner takes the view that “printing by reference” as a concept has been disclosed and this renders all manifestations, improvements, variations, etc. obvious. Such sweeping statements demonstrate the predisposition to reject the present claims, as the claims are not directed to a vague “print by reference concept” (nor is Eldridge, for that matter; see, e.g., Eldridge, C9, L44 – C10, L13).

Also, Eldridge does disclose communication rules and regulations. See, e.g., Eldridge, FIGs. 4-7; abstract, L7-20; C1, L32-35; C2, L6-24; C8, L6-20; C8, L41-46; C9, L10-13; C9, L26-34; C9, L44 – C10, L13; C11, L55 – C12, L7; C13, L27-35; C14, L26-42. The token-based servers used by Eldridge define an independent token-based protocol (see, e.g., Eldridge, C1, L20-35; C2, L6-24; C9, L10-13; C9, L44 – C10, L13; C11, L55 – C12, L7; C14, L26-42), and it is not clear how the additional references suggest modification of a token based protocol.

**D. The 35 U.S.C. § 103(a) Rejection of Claim 8 as Being Unpatentable Over Eldridge in View of Petteruti, W3C, and Gase Should Separately be Reversed, as There is No Provided Motivation for Using SOAP in Eldridge.**

In addition to the features stated above regarding claim 7, a specific invention for leveraging existing SOAP for printing by reference support is defined in claim 8. Claim 8 additionally defines, among other things, that “the argument resolution protocol is the Simple Object Access Protocol”. Eldridge fails to teach or suggest this feature, and there is no provided motivation to modify Eldridge in this way.

With respect to claim 8, the Examiner (October 4, 2005 Office Action, P5, L19 – P6, L2) cites W3C SOAP 1.1 for teaching the SOAP protocol, and states it would have been obvious to one skilled in the art at the time of the invention to have used SOAP as

taught by W3C to initiate control communication in the method taught by Eldridge and Petteruti because “SOAP can be binded to HTTP, providing the advantage of being able to use the formalism and the centralized flexibility of SOAP with the rich feature set of HTTP.”

However, there is no suggestion in the applied references of leveraging an argument resolution protocol, and certainly not SOAP, for printing by reference in Eldridge. Claim 8 provides a specific solution that leverages existing protocols (instead of relying on, as in Eldridge, a unique token resolution protocol (see, e.g., C1, L20-35; C9, L44 – C10, L13) for providing printing by reference.

The Examiner submits (October 4, 2005 Office Action, P14, L19 – P15, L2) that “SOAP is a lightweight protocol for exchange of information in the centralized distributed environment”, and that “the print by reference concept does not [require] a particular type of protocol … and this is the reason why Eldridge does not [disclose] any communication rules and regulation.” However, again, the fact that SOAP is a “lightweight protocol” in no way suggests its use in Eldridge, where Eldridge delivers encoded tokens over the web (C1, L20-32; C8, L1-10). Further, as stated above, the token-based servers used by Eldridge do define an independent protocol (see, e.g., C1, L20-35; C2, L6-24; C9, L10-13; C9, L44 – C10, L13; C11, L55 – C12, L7; C14, L26-42), and it is not clear how the additional references suggest modification according to SOAP of the unique, specific, and deliberate token-based protocol relied upon in Eldridge.

#### **IV. The 35 U.S.C. §103(a) Rejection of Claim 9 as Being Unpatentable Over Eldridge and Holtzman.**

Applicants submit that the rejection of claim 9 should be rejected for at least the reasons stated above regarding independent claim 1, which are incorporated herein.

**V. The 35 U.S.C. §103(a) Rejection of Claim 10 as Being Unpatentable Over Eldridge and Holtzman, and Further in View of Hull.**

Applicants submit that the rejection of claim 10 should be reversed for at least the reasons stated above regarding independent claim 1, which are incorporated herein.

**VI. The Rejection of Claim 11 Under 35 U.S.C. §103(a) as Being Unpatentable Over Eldridge, Iwata, and Hall.**

Applicant submits that the rejection of claim 11 should be reversed for the reasons submitted above regarding independent claim 1, which statements are incorporated herein.

**VII. The 35 U.S.C. §103(a) Rejection of Claims 12-13 as Being Unpatentable Over Eldridge and Srinivasan.**

Applicant submits that the rejection of claims 12-13 should be reversed for the reasons submitted above regarding independent claim 1, which statements are incorporated herein.

**VIII. The 35 U.S.C. §103(a) Rejection of Claims 14, 16, 23-29, 32, and 34-35 as Being Unpatentable Over the Rejections for Claim 1-13.**

Applicants respectfully submit that the rejection of claims 14, 16, 23-29, 32, and 34-35 should be reversed for at least the reasons stated above regarding independent claim 1, which statements are incorporated herein.

Applicants further submit that claims 27-29, further defining that software receives a control communication via an argument resolution protocol, are separately allowable for at least the reasons stated above regarding independent claim 7, which remarks are incorporated herein.

Applicants further submit that claim 28, further defining that the argument resolution protocol is SOAP, is separately allowable for at least the reasons stated above regarding dependent claim 8, which remarks are incorporated herein.

**IX. The 35 U.S.C. § 103(a) Rejection of Claim 15 as Being Unpatentable Over Eldridge.**

Applicant respectfully submits that the rejection of claim 15 should be reversed based at least on the reasons stated above regarding claim 1, which statements are incorporated herein, as applied to independent claim 14.

**X. The 35 U.S.C. § 103(a) Rejection of Claims 17-19 and 21 as Being Unpatentable Over Eldridge and Srinivasan.**

Applicants respectfully submit that claims 17-19 and 21 should be allowable for at least the reasons stated above regarding claim 1, which are incorporated herein, as applied to independent claim 14.

**XI. The 35 U.S.C. §103(a) Rejection of Claim 20 as Being Unpatentable Over Eldridge, Srinivasan, and Olkkonen.**

Applicant respectfully submits that the rejection of claim 20 should be reversed for at least the reasons regarding independent claim 1, which reasons are incorporated herein, as applied to independent claim 14.

**XII. The 35 U.S.C. § 103(a) Rejection of Claims 30-31 as Being Unpatentable Over Eldridge, Petteruti, W3C, and Gase.**

Applicants respectfully submit that the rejection should be reversed for at least the reasons stated above regarding independent claim 1, which reasons are incorporated herein, as applied to independent claim 14.

Applicants further submit that the rejection of claims 30-31, further defining that software accepts control communications via an argument resolution protocol, should be reversed for at least the reasons stated above regarding claim 7, which reasons are incorporated herein as well.

**XIII. The 35 U.S.C. § 103(a) Rejection of Claim 33 as Being Unpatentable Over Eldridge, Hull, and Reece.**

Applicants respectfully submit that the rejection should be reversed for at least the reasons stated above regarding independent claim 14, which reasons are incorporated herein.

**CONCLUSION**

For the above reasons, Applicant requests the Board to reverse the outstanding rejections.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By



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April 6, 2006

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## CLAIMS APPENDIX

1. A method for serving a print by reference operation to print referenced content from a referenced location of a content provider to a print device, the method comprising steps of:

accepting, from a print client, a reference to print content targeted for printing from a content provider location indicated by the reference;

resolving the reference to determine the location indicated by the reference;

obtaining print data from the location indicated by the reference;

transcoding the print data into a print device ready format;

allowing access to print data transcoded by said step of transcoding;

transferring, in response to a request from the print client, print data transcoded by said step of transcoding.

2. The method according to claim 1, wherein said step of accepting accepts the reference from an Internet connection to the print client.

3. The method according to claim 1, wherein the reference comprises a universal resource locator address that addresses print content targeted for printing.

4. The method according to claim 1, wherein said step of accepting accepts a reference list of individual references that each reference print content stored at a content provider location.

5. The method according to claim 4, wherein said steps of resolving, obtaining, transcoding, and allowing are completed for a first one of said individual

references in said reference list before being conducted for another one of said individual references in said reference list.

6. (Cancelled)

7. A method for serving a print by reference operation to print referenced content from a referenced location of a to a print device, the method comprising steps of:

accepting, from a print client, a reference to print content targeted for printing from a location indicated by the reference;

resolving the reference to determine the location indicated by the reference;

obtaining print data from the location indicated by the reference;

transcoding the print data into a print device ready format;

allowing access to print data transcoded by said step of transcoding;

transferring, in response to a request from the print client, print data transcoded by said step of transcoding,

initiating a control communication with the print client, wherein said step of initiating a control communication is conducted via an argument resolution protocol and said steps of accepting and transferring are conducted via a data transfer protocol.

8. The method according to claim 7, wherein the argument resolution protocol is the Simple Object Access Protocol and the data transfer protocol is an HTTP protocol.

9. The method according to claim 1, further comprising steps of:  
accepting a security challenge from the location indicated by the reference; and  
responding to the security challenge.

10. The method according to claim 9, wherein said step of responding comprises passing the security challenge to the print client.

11. The method according to claim 1, wherein said step of allowing comprises:

establishing a universal resource locator address for the print data transcoded by said step of transcoding; and

communicating the universal resource locator address for the print data to the print client.

12. The method according to claim 1, further comprising a step of conducting a financial clearance.

13. The method according to claim 1, further comprising a step of requiring a billing ID from the print client.

14. A print service realized as a computer program product comprising a computer usable medium having computer readable program code embodied in the medium that when executed causes a computer to:

accept a reference from a print client to print content targeted for printing from a content provider location indicated by the reference;

resolve the reference to determine the location indicated by the reference;

obtain the print content from the location indicated by the reference;

transcode the print content into a print device ready format;

allow access to the transcoded print content; and

transfer the transcoded print content to the print client in response to a request from the print client.

15. The print service according to claim 14, wherein the software accepts the reference from a direct connection to the print client.

16. The print service according to claim 14, wherein the software accepts the reference from an Internet connection to the print client.

17. The print service according to claim 14, wherein said software is resident in a web host and the print service is a web site allowing the print service to be reached by the print client via the Internet.

18. The print service according to claim 17, wherein the web site is discoverable by the print client through the Internet.

19. The print service according to claim 18, wherein the web site is pre-configured into print clients to be discoverable when print services are required by the print clients.

20. The print service according to claim 18, wherein the web site is registered into a service registry to be discoverable by print clients.

21. The print service according to claim 18, wherein the web site is discoverable via network discovery protocols.

22. (Cancelled)

23. The print service according to claim 14, wherein the software accepts a reference comprising multiple references to print content targeted at multiple content provider locations for printing.

24. The print service according to claim 23, wherein the multiple references comprise a list of multiple Universal Resource Locators.

25. The print service according to claim 23, wherein each of the multiple references is processed separately followed by sequential processing of remaining references in a list.

26. The print service according to claim 14, wherein the print service, at the time the software accepts a reference, the reference receives a control communication with the print client over a control communication channel and opens a separate data channel for data exchange.

27. The print service according to claim 26, wherein the software receives the control communication via an argument resolution protocol.

28. The print service according to claim 27, wherein the argument resolution protocol is the Simple Object Access Protocol.

29. The print service according to claim 27, wherein the argument resolution protocol is layered on top of an HTTP protocol.

30. The print service according to claim 27, wherein the software accepts control communications via the argument resolution protocol to:

create a new print job;  
check status of an existing print job; and  
cancel an existing print job.

31. The print service according to claim 30, wherein the software accepts a request to create a new print job from the print client.

32. The print service according to claim 31, wherein the software creates a unique job identifier when accepting a request to create a new print job from the print client and communicates the job identifier to the print client for use in further communications concerning the new print job.

33. The print service according to claim 14, wherein the software transcodes into a form that depends on a device type of the print client.

34. The print service according to claim 14, wherein the software conducts a financial clearance of the print client.

35. The print client according to claim 14, wherein the software requires a billing ID from the print client.

## EVIDENTIARY APPENDIX A



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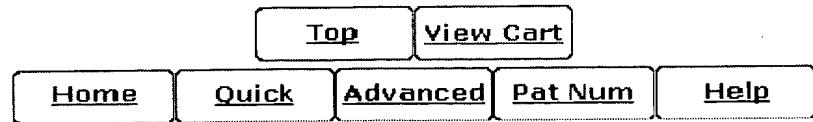
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- 1 [6,980,984](#) T Content provider systems and methods using structured data
- 2 [6,807,641](#) T Content provider system
- 3 [6,804,675](#) T Online content provider system and method
- 4 [6,799,214](#) T System and method for efficient content delivery using redirection pages received from the content provider original site and the mirror sites
- 5 [6,778,982](#) T Online content provider system and method
- 6 [6,721,748](#) T Online content provider system and method
- 7 [6,597,776](#) T Method and system for allowing extended connections to content providers via prepaid content provider accounts
- 8 [6,516,349](#) T System for updating a set of instantiated content providers based on changes in content provider directory without interruption of a network information services
- 9 [6,389,463](#) T Internet radio receiver having a rotary knob for selecting audio content provider designations and negotiating internet access to URLs associated with the designations
- 10 [6,275,496](#) T Content provider for pull based intelligent caching system
- 11 [6,246,755](#) T Method and system for connecting a caller to a content provider



RELATED PROCEEDINGS APPENDIX

(None)

**CERTIFICATE OF SERVICE**

(None). (This is not a reexam proceeding and none is required).